

This Opinion is Not a  
Precedent of the TTAB

Mailed: February 24, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

*In re Renaissance Jewelry New York, Inc.*

Serial Nos. 88304005 and 88584338

Oliver R. Chernin of McLaughlin & Stern LLP  
for Renaissance Jewelry New York, Inc.

Shaila E. Lewis, Trademark Examining Attorney, Law Office 114,  
Nicole Nguyen, Acting Managing Attorney.

Before Wolfson, Adlin and Johnson, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant, Renaissance Jewelry New York, Inc., seeks Supplemental Register registrations for the mark MADE FOR YOU LAB-GROWN DIAMONDS, in standard characters and the form shown below



<sup>1</sup> Application Serial Nos. 88304005 and 88584338, filed February 15 and August 19, 2019, and referred to as the “005” and “338” Applications, respectively. Applicant originally sought Principal Register registrations under Section 1(b) of the Trademark Act based on an alleged intent to use the mark in commerce, and later amended each application to allege first use dates of December 2019 and to seek registration on the Supplemental Register. The ‘338

(“LAB GROWN DIAMONDS” disclaimed in each), for “diamonds; jewelry” in International Class 14. The Examining Attorney refused registration under: (1) Sections 1, 2 and 45 of the Trademark Act, on the ground that MADE FOR YOU LAB-GROWN DIAMONDS fails to function as a mark, because it does not indicate the source of Applicant’s goods, or identify and distinguish them from those of others; and (2) Section 23(c) of the Act on the ground that MADE FOR YOU LAB-GROWN DIAMONDS is a generic term for the identified goods, and thus incapable of distinguishing them from those of others.<sup>2</sup> After the refusals became final, Applicant appealed and filed requests for reconsideration that were denied. The appeals are fully briefed. We affirm the refusals to register.

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Application includes this description of the mark: “The mark consists of a purple colored rectangle, the purple colored words ‘MADE FOR YOU’ in stylized font in the center of the purple colored rectangle, and the purple colored words ‘LAB-GROWN DIAMONDS’ intersecting the center of the bottom line of the rectangle.”

<sup>2</sup> Applicant has not argued, either during prosecution or on appeal, that the rectangle design, purple color or stylization of the mark in the ’338 Application is sufficient to “carry” Applicant’s design mark to registration in the event the mark’s literal element is found to not function as a mark or to be generic. *Cf. In re Vox Populi Registry Ltd.*, 2020 USPQ2d 11289 at \*8-9 (TTAB 2020), *aff’d* \_\_\_ F.4th \_\_\_, 2022 WL 301855 (Fed. Cir. 2022) (stylized lettering of .SUCKS “does not create a separate commercial impression and is not sufficiently distinctive to ‘carry’ the overall mark into registrability”). Even if Applicant had made the argument, Applicant’s rectangle design is a quite common shape, and neither it nor its purple color, so dark as to appear almost black, are enough to distinguish the source of Applicant’s goods. *See e.g. In re Sadoru Grp.*, 105 USPQ2d 1484 (TTAB 2012); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002) (“However, ordinary geometric shapes such as circles, ovals, squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof of acquired distinctiveness.”); *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804, 1805 (TTAB 1990).

## **I. Appeals Consolidated**

These appeals involve common questions of law and fact and the records are quite similar. Accordingly, we consolidate and decide both appeals in this single decision. *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1214 (2021).

## **II. Evidence and Arguments**

The Examining Attorney argues, based primarily on dictionary definitions, Applicant’s specimen, and third-party and media uses of the terms, that “made for you” and “lab grown diamonds” are “ordinarily used in the jewelry industry to refer to a class of diamonds and/or jewelry,” and that when combined, the phrases remain generic and “do not function as a trademark.” 9 TTABVUE 6-13.<sup>3</sup> Applicant argues, based primarily on its specimen of use, caselaw, and the USPTO’s treatment of allegedly analogous applications and registrations, that while the proposed mark is merely descriptive, it is not “merely informational,” but rather is used “to refer to the retailer that is selling Applicant’s jewelry,” specifically Kohl’s. 7 TTABVUE 9.

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<sup>3</sup> Citations to the Appeal Briefs are to TTABVUE, the Board’s online docketing system, and unless otherwise indicated, citations are to the briefs in the ’005 Application. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. As for the application files, unless otherwise indicated, citations are to the record in the ’005 Application, specifically to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

### A. Dictionary Definitions

The Examining Attorney introduced the following dictionary definitions of the individual words comprising “made for you,”<sup>4</sup> as well as the term “custom-made”:

**MADE**—“invented or created, often in a particular manner,” “to have created something” and “constructed; shaped; formed; manufactured”<sup>5</sup>

**FOR**—“the purpose, destination, **recipient** or amount of something” and “as the representative of; in the interest of; acting *for* another”<sup>6</sup>

**YOU**—“pronoun used to describe someone that is being spoken to, or to describe a hypothetical person or group of people” and “any person: equivalent in sense to indefinite *one*: *you* can never be sure!”<sup>7</sup>

**CUSTOM-MADE**—“built to a specific order or specifications” and “made to order, according to the customer’s specifications”

November 20, 2019 Office Action TSDR 24, 26, 33, 37 (bold emphasis added).

### B. Applicant’s Specimen of Use

Applicant filed the specimen reproduced below in each application:

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<sup>4</sup> Applicant relies on essentially similar definitions. September 24, 2019 Office Action response TSDR 47-90.

<sup>5</sup> <https://www.yourdictionary.com/made>

<sup>6</sup> <https://www.yourdictionary.com/for>

<sup>7</sup> <https://www.yourdictionary.com/you>



Applicant claims that in the specimen it uses the proposed mark “to refer to [Kohl’s,] the retailer that is selling Applicant’s jewelry to the public,” and that the specimen is from a Kohl’s catalog. 7 TTABVUE 10.

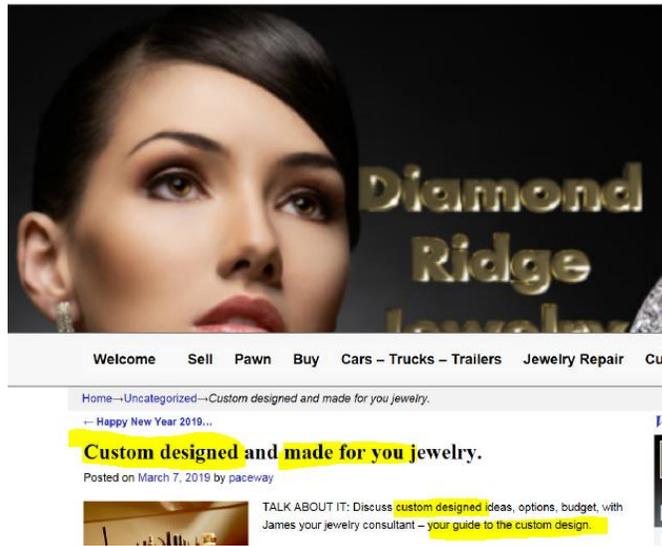
### C. Third Party and Media Uses of the Proposed Mark’s Constituent Phrases

The phrase “made for you” is often used by third-parties in connection with custom-made jewelry. The phrase “lab-grown diamonds” is often used by third-parties in connection with diamonds, including diamonds used in jewelry.

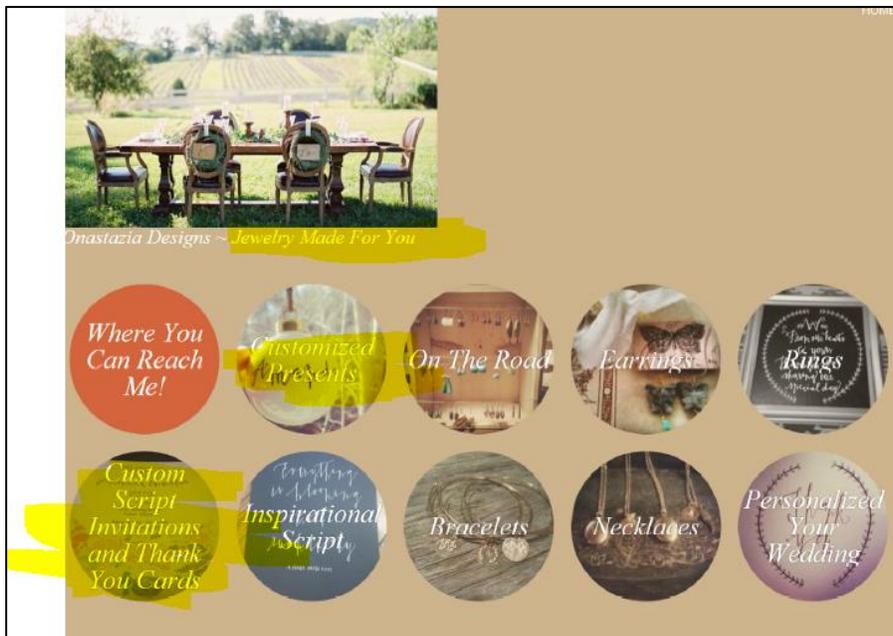
#### 1. “MADE FOR YOU”

Third-party uses of “made for you” for custom-made jewelry make clear that the phrase is used and understood as a synonym for made-to-order jewelry. For example, Diamond Ridge Pawn uses “made for you” to refer to “custom designed” jewelry:

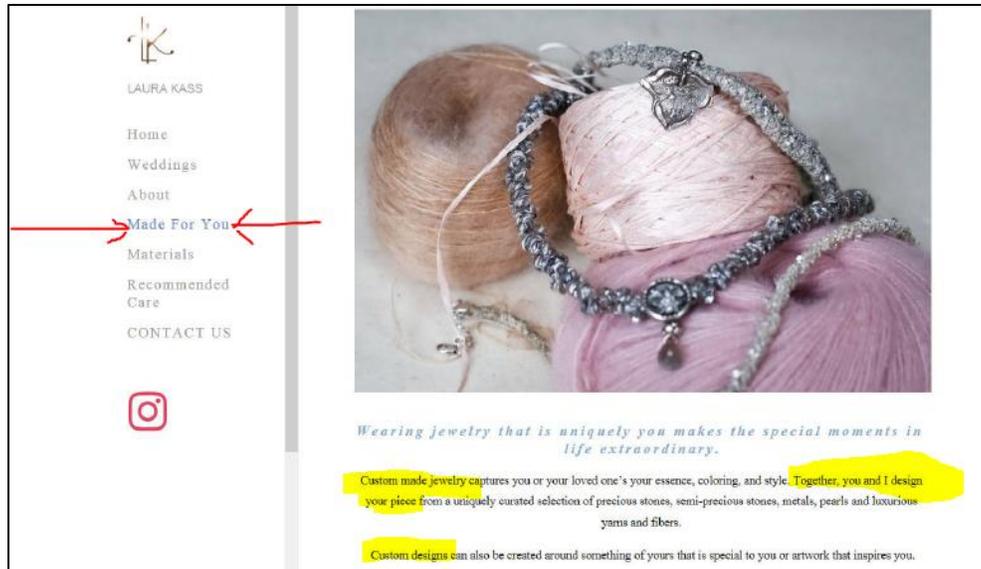
### Diamond Ridge Pawn – Jewelry



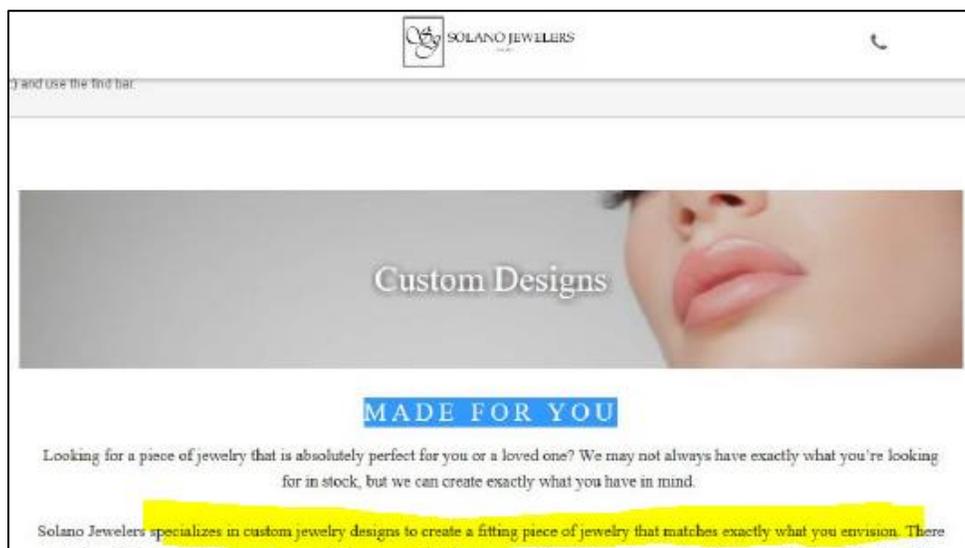
April 27, 2019 Office Action TSDR 4 (highlighting added). Onastazia Designs uses “made for you” in connection with not just custom jewelry, but also “custom script invitations and thank you cards” and “customized presents”:



*Id.* at 6 ((highlighting added). The custom jewelry section of the Laura Kass website falls under the heading “Made For You” and refers to “custom made jewelry”:

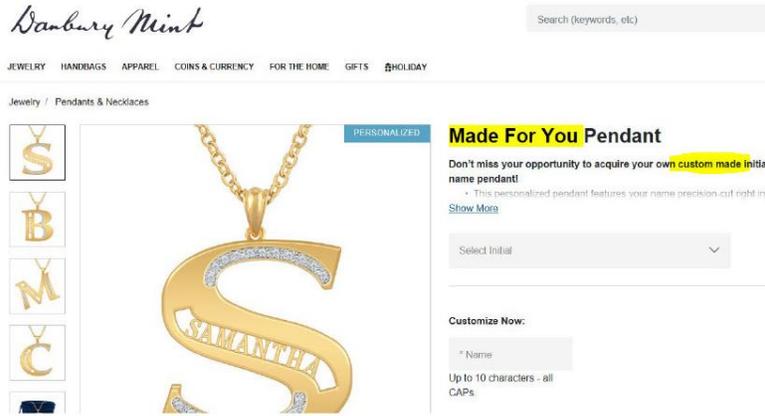


*Id.* at 7 (highlighting added). The “Custom Designs” section of the Solano Jewelers website, under the subheading “Made for You,” explains that the company “specializes in custom jewelry designs to create fitting piece of jewelry that matches exactly what you envision”:



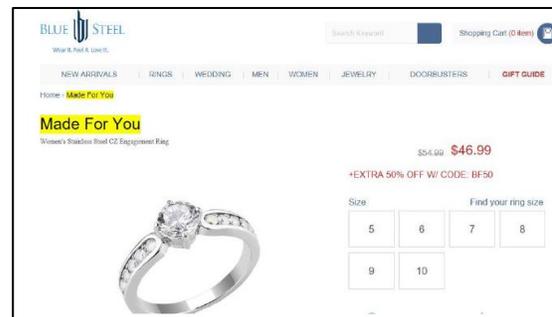
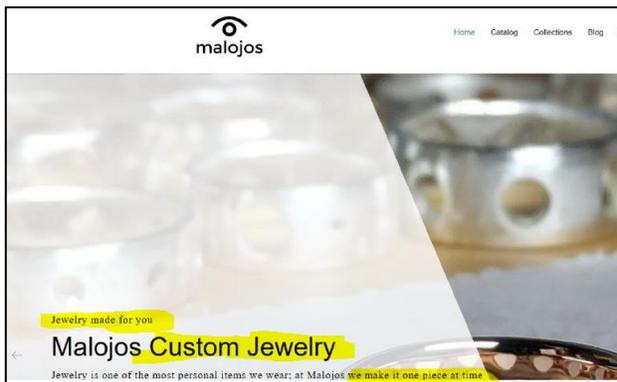
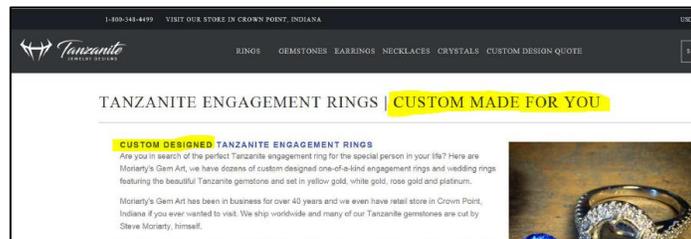
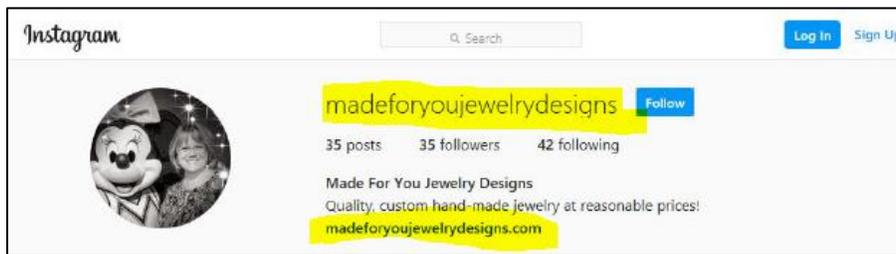
November 20, 2019 Office Action TSDR 14 (highlighting added). Danbury Mint offers a “**Made For You Pendant**,” which is a “custom made initial name pendant!”:

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December 1, 2020 Office Action TSDR 12 (highlighting added).

Additional examples of jewelers and other jewelry sources using “made for you” include the following:



December 1, 2020 Office Action TSDR 5, 16, 29 (highlighting added); April 27, 2019 Office Action TSDR 9, 14 (highlighting added).

There are many more examples showing use of “made for you” in connection with jewelry or diamonds, including:

Golden Names Jewelers, under the heading “Stunning Custom Jewelry **Made for You**,” promotes jewelry “able to be personalized as you like.” November 20, 2019 Office Action TSDR 18 (emphasis added).

The King’s Jewelers website includes a made-to-order jewelry section under the heading “Custom Jewelry: **Made for You**,” in which the colon between “Custom Jewelry” and “Made for You” reveals how the phrase “made for you” will be perceived by jewelry consumers. *Id.* at 21 (emphasis added).

The Noetic Effect website offers “Jewelry Custom **Made for You**,” and photos of the company’s prior work identify pieces as either “Custom **Made for You**” or simply “**Made for You**.” *Id.* at 22-23 (emphasis added).

The Knox Diamonds & Jewelry website includes a section called “KDJ Designs – **custom made for you**” which explains that “KDJ Designs is the designer name of jewelry created by Knox Diamonds and Jewelry. We custom make Engagement Rings ....” May 1, 2020 Office Action TSDR 9 (emphasis added).

The Shiree Odiz New York website includes a “Bespoke Engagement Ring” section which states “Every engagement ring is **made for you**. Whether it’s a custom engagement ring or personalized engagement ring.” *Id.* at 13 (emphasis added).

Similarly, Concierge Diamonds “believe[s] that an engagement ring shouldn’t be something bought off the rack. It shouldn’t be a ring that 10,000 other people are wearing. It should be **made for you**. The way you want it. The way you like it.” *Id.* at 15 (emphasis added).

The “Custom Jewelry” section of the House of Diamonds website includes the subheading “Custom Earrings **Made for You**” under which is an answer to the question “Why Choose House of Diamonds for Custom Earrings.” May 1, 2020 Office Action TSDR 59 (emphasis added).

The Malik Made website includes the slogan “Timeless Custom Jewelry **Made for You.**” *Id.* at 52 (emphasis added).

Yearly Co.’s website, under the heading “**Made for You**” states “[e]ach Yearly Co. piece is made to order.” *Id.* at 75 (emphasis added).

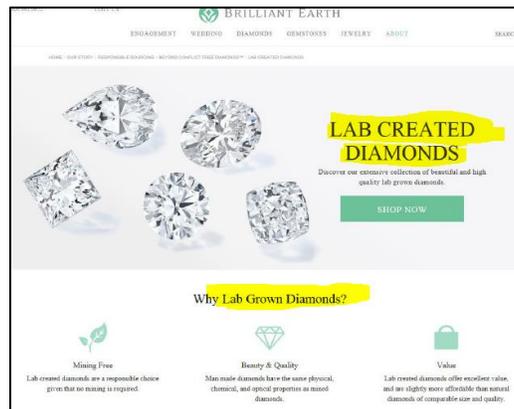
The “What is Custom?” section of Lindsey Scoggins Studio’s website appears beneath the heading “**MADE FOR YOU**” and answers the question as follows: “beautiful jewelry that was designed specifically for the woman who would wear it,” with pieces “all made to measure.” *Id.* at 77 (emphasis added).

Sometimes “made for you” is used more broadly, to refer to jewelry which is not necessarily made-to-order, but is nevertheless appropriate for each specific consumer. For example, a “refinery29.com” article about Svelte Metals entitled “Got Tiny Wrists and Fingers? This New Jewelry Line is **Made for You**” explains that sometimes people with “petite arms and wrists” may sometimes lose jewelry pieces that “wash down the drain,” a problem solved by the new line. November 20, 2019 Office Action TSDR 4 (emphasis added). The My Fairs and Festivals website includes a listing for a “**Made For You** Jewelry Show.” May 1, 2020 Office Action TSDR 55 (emphasis added). The company “heard those cries of frustration and has introduced a collection of **specially designed** accessories to solve all those woes.” *Id.* (emphasis added). Another third party uses the term in a manner that may refer to made-to order diamonds as opposed to jewelry. Specifically, the Naturally Colored website, under

the heading “Custom **made for YOU**” states “A unique diamond makes a unique jewel! Think it, design it and make it.” *Id.* at 20 (emphasis added). Kinnari Designs offers a “**Made For You** Collection” which includes earring designs “custom made for someone” which are “available to order” as is, “or as inspiration for your own custom designed pair.” *Id.* at 85 (emphasis added).

## 2. “LAB-GROWN DIAMONDS”

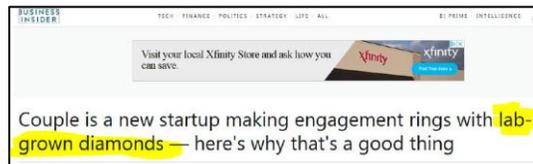
Third-party and media uses of “lab-grown diamonds” in connection with diamonds and diamond jewelry make clear that the phrase is used and understood as a synonym for diamonds created in a lab. For example, Brilliant Earth uses the terms “lab-grown diamonds” and “lab created diamonds” interchangeably:



April 27, 2019 Office Action TSDR 20 (highlighting added). As its website explains, “[m]an made diamonds also known as engineered or cultured diamonds, are grown in highly controlled laboratory environments using advanced technological processes that duplicate the conditions under which diamonds naturally develop when they form in the mantle, beneath the earth’s crust.” *Id.* at 21. The diamonds are “grown

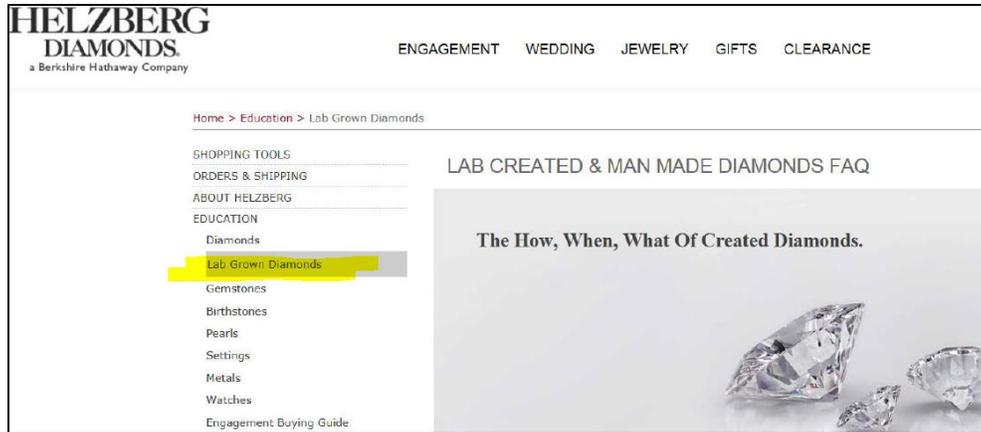
from the tiny carbon seeds of pre-existing diamonds” using “advanced technology.”  
*Id.*

A BUSINESS INSIDER article about a lab-grown diamond startup uses the term not to identify the startup, but rather the type of diamonds the business produces, as revealed by the article’s title “Couple Is a New Startup Making Engagement Rings With Lab-Grown Diamonds – Here’s Why That’s a Good Thing”:



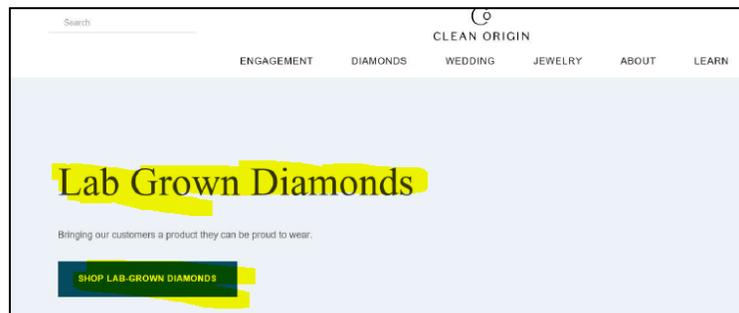
*Id.* at 24 (highlighting added). The article explains that “lab-grown diamonds are chemically identical to mined diamonds but don’t carry the same environmental and ethical problems and are just as beautiful and durable.” *Id.* at 25. Similarly, a bbc.com article entitled “The Sparkling Rise of the Lab Grown Diamond” uses the term not to identify a specific lab-grown diamond manufacturer or merchant, but instead to refer to lab-grown diamonds themselves, without regard to who makes or sells them. May 1, 2020 Office Action TSDR 35-47. According to the article, “[l]ab-grown diamonds are a rapidly growing trend in the industry. Young diamond-buyers are drawn to them by price, transparency and for environmental reasons, with this segment of the market increasing by between 15% and 20% annually ... The growth is expected to continue as more jewelers start to sell lab diamonds and more labs are launched.” *Id.* at 38.

The Helzberg Diamonds website’s “Lab Grown Diamonds” link leads to “frequently asked questions” about “lab created & man made diamonds”:



April 27, 2019 Office Action TSDR 40 (highlighting added). In other words, “lab grown diamonds” is synonymous with “lab created diamonds” or just “created diamonds,” as revealed by the header “The How, When, What of Created Diamonds.” Thus, “lab-grown diamonds’ are a type of diamonds, not an identifier of any particular source thereof.

Clean Origin, which like Helzberg Diamonds, Couple and Brilliant Earth is one of Applicant’s competitors, sometimes uses the term “lab grown diamonds” without a hyphen between “lab” and “grown” (first highlighted portion below), and sometimes uses the term with a hyphen (second highlighted portion below), as Applicant does:



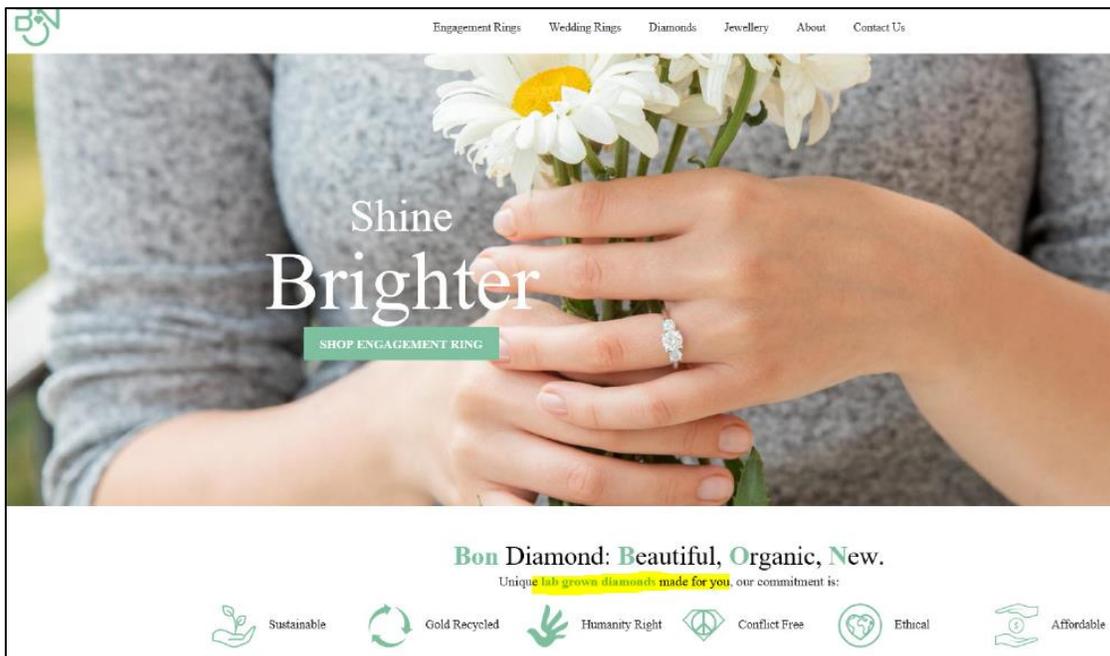
May 1, 2020 Office Action TSDR 22 (highlighting added). This and the other evidence shows that there is no meaningful distinction between “lab grown diamonds” without a hyphen and “lab-grown diamonds” with a hyphen, and that jewelers and diamond

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merchants commonly use the phrase to refer to man-made as opposed to natural diamonds. In addition to Clean Origin, Diamond Nexus, in the “Lab Grown Diamonds” section of its website, specifically refers to lab-grown diamonds as “man made,” as well as “grown or synthetic” (as opposed to “mined”). *Id.* at 25.

### 3. Third-Party Use of “Made for You” and “Lab Grown Diamonds” Together

There is even one third-party, Bon Diamond, that, like Applicant, uses the phrases “Made for You” and “Lab Grown Diamonds” together, as “lab grown diamonds made for you”:



May 1, 2020 Office Action TSDR 17 (highlighting added).

### D. Applicant’s and Third Parties’ Allegedly Analogous Applications and Registrations

For its part, Applicant relies on its own abandoned intent to use applications for marks containing MADE FOR YOU for “diamonds; jewelry” which Applicant alleges

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were approved for publication. May 27, 2021 Request for Reconsideration TSDR 15-24.<sup>8</sup> However, the record does not reveal that any of these marks ever registered.

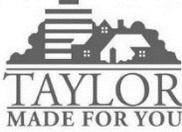
Applicant also relies on third-party applications and registrations for what it alleges are analogous marks, and alleges that the pending applications have been approved for publication.<sup>9</sup> The registered third-party marks upon which Applicant relies are as follows:

<u>Mark/Registration No.</u>	<u>Goods/Services</u>
BOW TIE BAR TAILOR-MADE FOR YOU (“BOW TIE” and “TAILOR-MADE FOR YOU” disclaimed) Reg. No. 5814907	downloadable mobile applications for customizing and designing articles of clothing including bow ties, neck ties, socks, shirts, pocket squares
MADE FOR YOU Reg. No. 5407627	on-line retail store services featuring hair color

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<sup>8</sup> Application Serial Nos. 87435384, 87435372 and 87435363. Applicant claims that these applications were abandoned because it failed to file Statements of Use. May 27, 2021 Request for Reconsideration TSDR 8. Thus, these applications are not analogous to the involved applications, because determinations that a term fails to function as a mark are typically based on specimens of use. TMEP § 1202 (2021) (“The issue of whether a designation functions as a mark usually is tied to the use of the mark, as evidenced by the specimen.”). The failure to function refusals in the involved applications did not issue until after Applicant filed its Amendments to Allege use and, more importantly, specimens. May 1, 2020 Office Action TSDR 1-3.

<sup>9</sup> Applications, even those which have been published for opposition, and perhaps especially those which have been abandoned, have “no probative value other than as evidence that the application was filed.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)). See also *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (“most of the marks Applicant cites are the subject of cancelled registrations, abandoned applications, or pending applications and none of these categories provide probative support for Applicant’s argument”).

<u>Mark/Registration No.</u>	<u>Goods/Services</u>
 Reg. No. 5404238	organizing community sporting and cultural events; organizing live performances in the nature of live music performances and motion picture showings as part of a cultural event; golf courses; recreational park services; providing facilities for recreational activities; providing online information regarding community sporting and cultural events; golf courses and recreational park services, and the provision of all of the foregoing services and events is limited to trade channels relating to municipal uses only and "Taylor" identifies the name of a municipality
 ("BLINDS" disclaimed) Reg. No. 5223823	electronic commerce services, namely, providing information about window covering products via telecommunication networks for advertising and sale purposes; distributorship services in the field of window coverings
MADE FOR YOU TO LOVE Reg. No. 5205241	frozen prepared entrees consisting primarily of meat, fish, seafood, poultry, or vegetables; frozen prepared snacks consisting primarily of meat, fish, seafood, poultry or vegetables; vegetable soufflés; stuffed peppers; frozen entrees consisting primarily of egg, meat, vegetables, and cheese  and  frozen prepared entrees consisting primarily of pasta or rice; frozen prepared snacks consisting primarily of pasta or rice; pot pies; lasagna; macaroni and cheese; pizza; frozen pizza
 Reg. No. 4903727	craft ovens in the nature of kilns  arts and craft clay kits; arts and craft paint kits; canvas for painting; drawing brushes; liquid paint felt tip marking and coloring applicators; modeling clay; modeling clay for children; modelling clay; molds for modeling clays; moulds for modelling clays; paint applicator rollers; paint applicators; paint applicators in the nature of sponges; paint boxes and brushes; paint brushes; paint rollers; painters' brushes; painting palettes; painting sets for children; pencils

<u>Mark/Registration No.</u>	<u>Goods/Services</u>
	<p>for painting and drawing; stencils for transfer of graphic design onto any surface</p> <p>plaster figurines</p> <p>and</p> <p>hobby craft kits for making toy ornaments, stuffed toy animals, toy figurines, toy sun catchers, toy walking figurines, toy race cars, toy trinket boxes, toy music boxes, toy jewelry, light-up toy statues, toy magnets</p>
 <p>Reg. No. 3172520</p>	<p>ignition wires, spark plug wires, spark plug wire organizers, and engine wire loom kits</p> <p>hand tools namely adjustable wrenches computer cable organizers</p> <p>vehicular aftermarket parts and accessories namely, brake light assemblies, towing hitch assemblies, and air spoiler repair kits</p> <p>and</p> <p>wearing apparel namely, t-shirts, shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes, sandals and belts</p>
<p>MADE FOR YOU ALONE</p> <p>Reg. No. 2583667</p>	<p>design services, namely, custom design of market umbrellas and patio umbrellas for others</p>
<p>MADE FOR YOU</p> <p>Reg. No. 6045071</p>	<p>shavers, namely, razors, razor blades and razor blade refill cartridges</p>
<p>MADE FOR YOU TO LOVE</p> <p>Reg. No. 5205241</p>	<p>frozen prepared entrees consisting primarily of meat, fish, seafood, poultry, or vegetables; frozen prepared snacks consisting primarily of meat, fish, seafood, poultry or vegetables; vegetable soufflés; stuffed peppers; frozen entrees consisting primarily of egg, meat, vegetables, and cheese</p> <p>and</p>

<u>Mark/Registration No.</u>	<u>Goods/Services</u>
	frozen prepared entrees consisting primarily of pasta or rice; frozen prepared snacks consisting primarily of pasta or rice; pot pies; lasagna; macaroni and cheese; pizza; frozen pizza
<p>FORMULATED BY PHYSICIANS, MADE FOR YOU.</p> <p>Reg. Nos. 6323608 and 6323607</p>	<p>industrial oil</p> <p>and</p> <p>non-medicated skin care preparations; Non-medicated skin care preparations, namely, skincare preparations, namely, topical creams, oils, and lotions containing industrial hemp oil solely derived from hemp, with a delta-9 tetrahydrocannabinol concentration of not more than 0.3 percent on a dry weight basis</p>

*Id.* at 25, 33-46; November 1, 2020 Office Action response TSDR 8.<sup>10</sup>

### III. Does MADE FOR YOU LAB-GROWN DIAMONDS Function as a Mark?

“The Trade-Mark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration.” *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960). Thus, we start our analysis with the Act’s definition of a trademark, which is “any word, name, symbol, or device, or any combination thereof – (1) used by a person ... to identify and distinguish his

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<sup>10</sup> Applicant also introduced Supplemental Register Registration Nos. 2398772 and 4173096, and Principal Register Registration Nos. 1180126, 2365620, 4506628, 3288687, 2756272, 2586515, 2451941, 2448364, 1414540 and 3412990, but all of these registrations have been cancelled. May 27, 2021 Request for Reconsideration TSDR 26-81. *See Wal-Mart*, 129 USPQ2d at 1159 (“most of the marks Applicant cites are the subject of cancelled registrations, abandoned applications, or pending applications and none of these categories provide probative support for Applicant’s argument”).

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or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. *See also In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.”).

Whether the composite phrase MADE FOR YOU LAB-GROWN DIAMONDS falls within this definition and functions as a mark depends on whether the relevant public, i.e., purchasers or potential purchasers of Applicant’s diamonds and jewelry, would perceive the phrase as identifying the source or origin of Applicant’s goods. *See, e.g., In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983 at \*1-2 (TTAB 2019); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998) (“A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public.”); *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992). “To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.” *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (citations omitted).

Here, notwithstanding Applicant’s use of the phrase MADE FOR YOU LAB-GROWN DIAMONDS and apparent intent that it function as a mark, the dictionary, third-party and media use evidence reveals that the phrase does not perform the desired trademark function and does not fall within the Act’s definition of a mark. It will be perceived not as a source identifier, but instead as merely conveying

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information about Applicant's diamonds and jewelry. Specifically, the proposed mark conveys that Applicant's diamonds and jewelry are custom-made or made-to-order ("MADE FOR YOU") and that Applicant's jewelry includes diamonds that are not natural but are instead man-made diamonds ("LAB-GROWN DIAMONDS"). In fact, Applicant's proposed standard character mark is a merely informational combination of two widely used phrases, and Applicant's proposed design mark merely adds a common geometric shape as a background carrier. Applicant's competitors and other third parties should be able to freely use MADE FOR YOU and LAB-GROWN DIAMONDS, either together or separately.

The record leaves no doubt about how relevant consumers will perceive the phrase "made for you" in the proposed mark MADE FOR YOU LAB-GROWN DIAMONDS. Indeed, it is not just the dictionary evidence which reveals that the phrase "made for you" refers to custom-made or made-to-order goods. To the contrary, the third-party and media uses of record reveal that the meaning conveyed by "made for you" is entirely consistent with the dictionary definitions of the phrase's constituent terms, both as a general matter and in the specific context of diamonds and jewelry. For example: Diamond Ridge Pawn, Laura Kass, Solano Jewelers, Danbury Mint, Tanzanite Jewelry Designs, Malojos, Golden Names Jewelers, The King's Jewelers, Noetic Effect, Knox Diamonds & Jewelry, Shiree Odiz New York, Concierge Diamonds, House of Diamonds, Malik Made, Yearly Co. and Lindsey Scoggins Studio all equate "made for you" jewelry with "custom designed," "made-to-order," "made-to-measure" or "custom made" jewelry. April 27, 2019 Office Action TSDR 4, 7, 14;

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November 20, 2019 Office Action TSDR 14; December 1, 2020 Office Action TSDR 12, 16. Onastazia Designs uses the phrase with not just “custom” jewelry, but also “custom” invitations, cards and presents, illustrating that the relevant public’s understanding of the phrase generally is consistent with how the phrase is used for jewelry and diamonds specifically. April 27, 2019 Office Action TSDR 6.

The record also leaves no doubt about how relevant consumers will perceive the phrase “lab-grown diamonds” in the proposed mark MADE FOR YOU LAB-GROWN DIAMONDS. Whether diamonds are referred to as “lab-grown,” “lab created” (or simply “created”), “synthetic” or “man-made,” the consuming public’s perception is the same – this type of diamond is “grown” in laboratories rather than produced naturally underground.

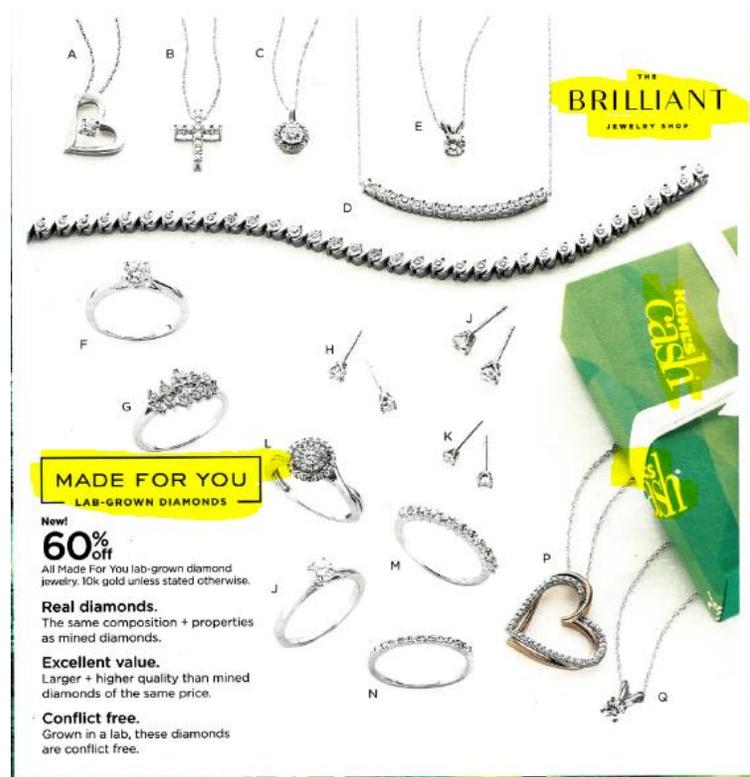
There is no evidence that MADE FOR YOU LAB-GROWN DIAMONDS is anything more than the sum of its two constituent phrases. On its face, the entire composite phrase’s meaning and how consumers will perceive it is obvious. The composite phrase informs relevant consumers – jewelry and diamond buyers – of two things: (1) the goods are, or contain, man-made diamonds; and (2) the goods are custom-made. Applicant’s disclaimers of “LAB-GROWN DIAMONDS” are probative evidence that Applicant does not assert exclusive rights in this phrase. *Cf. In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008).

The proposed mark’s failure to function as a mark is clear from Bon Diamond’s use of “lab grown diamonds made for you,” an essentially similar composite phrase

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that conveys information identical to that conveyed by Applicant's proposed mark, but does not identify Bon Diamond. May 1, 2020 Office Action TSDR 17. The two constituent phrases – “made for you” and “lab-grown diamonds” – go together naturally when used for jewelry or diamonds because the record reveals that both synthetic diamonds and made-to-order jewelry are popular, and synthetic diamonds are often used in made-to-order jewelry.

More importantly, it is also clear from Applicant's specimen that the composite phrase is nothing more than the sum of its parts and fails to function as a source indicator. The right-hand side of Applicant's specimen, as shown below, includes the words THE BRILLIANT JEWELRY SHOP displayed in a stylized manner in its upper right-hand corner, above what appears to be bags bearing the phrase KOHL'S CASH:



Either THE BRILLIANT JEWELRY SHOP or KOHL'S could be perceived as service marks for retail jewelry sales, as "shop" is a generic term for a retailer and "Kohl's" appears to be a surname in possessive form, a common type of trademark for retailers and other businesses.

By contrast, Applicant's MADE FOR YOU LAB-GROWN DIAMONDS design mark includes no indicia of source indication. To the contrary, it appears immediately above and summarizes the other descriptive matter appearing below it. That is, immediately under Applicant's proposed design mark are descriptive and generic terms and phrases essentially summed up by the proposed mark appearing above them, such as: "All Made For You lab-grown diamond jewelry."; "Real Diamonds"; "Larger + higher quality than mined diamonds of the same price."; "Conflict free"; and "Grown in a lab, these diamonds are conflict free." Thus, while arguably displayed in the manner of many trademarks, Applicant's proposed design mark is merely part of the informational material appearing on the lower-left side of the specimen. *See In re AOP LLC*, 107 USPQ2d 1644, 1654 (TTAB 2013) ("Set in the midst of other clearly informational matter, and far from the mark naming the wine itself, this use of the term 'AOP' does indeed convey nothing more than information itself and would not likely be perceived as a mark."); *see also In re Phoseon Technology, Inc.*, 103 USPQ2d 1822, 1828 (TTAB 2012). *See In re T.S. Designs, Inc.*, 95 USPQ2d 1669, 1671 (TTAB 2010) ("The likelihood that consumers will so perceive these words on the label [as informational matter] is enhanced because the label contains two clear source identifiers, namely 'tsdesigns.com' and 'printing t-shirts for

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good,' the latter specifically bearing the informal '™' designation while the phrase **Clothing Facts** does not.”).

Because the record shows that the phrases “made for you” and “lab-grown diamonds” are so commonly used in the jewelry industry, the composite phrase MADE FOR YOU LAB-GROWN DIAMONDS will not be perceived as identifying the products' sole source. *Cf. In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986) (“In an environment where consumers are accustomed to the use by merchants of similar informational phrases, we believe that consumers are not likely to view applicant's slogan as a service mark but rather as a merchandising slogan using common ordinary words merely to convey information about applicant's services.). Rather, the proposed mark will be perceived as merely informational, and as conveying that the products are both made-to-order and man-made. Indeed, this is exactly how many of Applicant's competitors use the same (and essentially similar) phrases.

Merely informational terms and phrases such as those in Applicant's mark do not function as marks. *See, e.g., In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960) (finding that GUARANTEED STARTING amounts “to no more than a sort of condensed announcement that the applicant will guarantee the work done in order to insure the starting of the customer's car”); *Wal-Mart*, 129 USPQ2d at 1152 (INVESTING IN AMERICAN JOBS does not function as a mark because it is “merely an informational statement that Applicant is selling certain goods that are made or assembled in America in areas of the store where the signage appears”); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS for retail clothing

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stores fails to function as a mark because it is merely an informational statement); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (affirming refusal to register FOR A DAY, A WEEK, A MONTH OR MORE! because it “is simply an ordinary informational statement about the availability of rooms for various lengths of time”); *In re Schwauss*, 217 USPQ 361 (TTAB 1983) (FRAGILE in stylized form does not function as a mark for labels and bumper stickers, but is instead “presented as a message or informational statement, rather than a source indicator”).

This case is analogous to *In re Phoseon Technology*, 103 USPQ2d at 1827-28, in which we found that SEMICONDUCTOR LIGHT MATRIX fails to function as a mark for light curing systems because it “identifies a technology, not the source of the UV curing system.” Here, in a manner analogous to *In re Phoseon*, Applicant’s proposed mark merely informs consumers that Applicant’s goods are lab-created and custom-made.

Finally, for several reasons, the third-party registrations Applicant cites do not establish that the composite phrase MADE FOR YOU LAB-GROWN DIAMONDS functions as a mark. First, none of them are similar to LAB-GROWN DIAMONDS in any way; they all include MADE FOR YOU or similar phrases only. Second, most of the cited marks are distinguishable from MADE FOR YOU standing alone, and are therefore not analogous to Applicant’s mark. For example, TAILOR-MADE FOR YOU is disclaimed in Registration No. 5814907. The mark TAYLOR MADE FOR YOU & Design is a double-entendre because “Taylor” is a surname in Registration No. 5404238. The phrase MADE FOR YOU in Registration No. 5223823 is the smallest

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feature of a multifaceted word and design mark. The term “made for you” is depicted as “MADE 4 U STUDIO” and “MADE 4 YOU” with prominent and distinctive designs in Registration Nos. 4903727 and 3172520. And the term “made for you” does not connote custom-made in Registration Nos. 5205241 (MADE FOR YOU TO LOVE) and 6323608 and 6323607 (FORMULATED BY PHYSICIANS, MADE FOR YOU). This leaves only three third-party registrations in which “made for you” apparently means “custom-made.” Third, all of the registrations Applicant cites “were issued at an earlier time for different marks, for different services or goods, and based on evidence and argument that are not of record. They are not evidence of consumers’ perception of the different mark,” MADE FOR YOU LAB-GROWN DIAMONDS for diamonds and jewelry. *In re Wal-Mart*, 129 USPQ2d at 1159. Indeed, it is settled that neither the existence of third-party registrations nor any of the evidence in their prosecution records (when it is of record) compels a specific result in later, allegedly analogous cases. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1377 (Fed. Cir. 2018) (“these prior registrations do not compel registration of [Applicant’s] proposed mar[k]”) (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant’s marks.”). As we recently stated in an analogous situation, “[w]e do not believe that our decision here is inconsistent with the registration of the third-party marks cited by Applicant, but to the extent that it

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is, it is the decision required under the statute on the record before us.” *In re Ala. Tourism Dept.*, 2020 USPQ2d 10485 at \*11 (TTAB 2020).

#### **IV. Conclusion**

Because the evidence of record shows that MADE FOR YOU LAB-GROWN DIAMONDS is a merely informational phrase it would not be perceived as an indicator of source in the context of Applicant’s identified goods. The term therefore fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act, and the design in the ’338 Application is not sufficiently distinctive to “carry” the composite phrase to registration.

**Decision:** The refusals to register the proposed mark MADE FOR YOU LAB-GROWN DIAMONDS in standard character and design form on the ground that the composite phrase does not function as a mark are affirmed in both applications.<sup>11</sup>

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<sup>11</sup> We need not reach the genericness refusals. *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018).